

Appln. No. 09/506,434
Amendment and Response to Office Action dated September 20, 2005
May 5, 2006

REMARKS

Applicants hereby file this Amendment and Response to the Office Action mailed on September 20, 2005 ("Office Action"). Claims 15, 17, 21, 55-58, 64, 65 and 68-76 are pending. Claims 15, 17, 21 and 55 have been amended and claims 68-76 have been added. No new matter has been added by way of these claim amendments. Support for new claims 68-76 can be found in the specification as originally filed at least at p. 5, line 22 to p. 6, line 2; p. 6, lines 6-10; and claims 9-12.

Claims 15, 17, 21, 55-58, 64 and 65 have been rejected under 35 U.S.C. § 112, first paragraph. See Office Action at ¶ 2. Claims 15, 17 and 55 have been rejected as allegedly unpatentable under 35 U.S.C. § 103(a) over USPN 5,819,236 to Josephson ("Josephson") in view of USPN 5,933,816 to Zeanah *et. al.* ("Zeanah") in view of USPN 5,930,778 to Geer ("Geer"). See Office Action at ¶ 5. Claims 21, 56-58, 64 and 65 have been rejected as allegedly unpatentable under 35 U.S.C. § 103(a) over Josephson and USPN 6,012,048 to Gustin *et. al.* ("Gustin") in view of Geer. See Office Action at ¶ 6.

I. Objections to the Specification.

Applicants thank the Examiner for withdrawing the previous objection to the specification. See Office Action at ¶ 3.

II. Rejection under 35 U.S.C. § 112, first paragraph.

Applicants thank the Examiner for withdrawing the rejection pursuant to 35 U.S.C. § 112, first paragraph for claims 1, 4, 6, 10, 11, 13, 50-64, 60-63, 66 and 67 as moot. See Office Action at ¶ 2. The Examiner has maintained the rejection of claims 15, 17, 21, 55-58, 64 and 65 under 35 U.S.C. § 112, first paragraph for allegedly failing to comply with the enablement requirement "as set forth here below." See Office Action at ¶ 2. Applicants respectfully submit that no grounds are stated in this Office Action for this rejection, and Applicants' previous response to this same rejection in the Restriction Requirement dated June 28, 2005 are not addressed in this Office Action. Applicants respectfully submit that the Examiner should take note of Applicants' argument and answer the substance of it. See MPEP § 707.07(f) ("Where the

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applicant traverses any rejection, the examiner should, if he or she repeats the rejection, *take note of the applicant's argument and answer the substance of it.*") (emphasis added).

Here, the Examiner has not stated any grounds for this rejection. Accordingly, Applicants respectfully submit that this rejection should be withdrawn because the Examiner has not met the initial burden of establishing a reasonable basis to question the enablement provided for the claimed invention. See MPEP § 2164.04 ("In order to make a rejection, the examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention," citing *In re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993) (examiner must provide a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled by the disclosure)).¹

III. Rejections Under 35 U.S.C. § 103(a).

Claims 15, 17 and 55 have been rejected as allegedly unpatentable under 35 U.S.C. § 103(a) over Josephson in view of Zeanah in view of Geer. See Office Action at ¶ 5. Claims 21, 56-58, 64 and 65 have been rejected as allegedly unpatentable under 35 U.S.C. § 103(a) over Josephson and Gustin in view of Geer. See Office Action at ¶ 6. Applicants respectfully submit that the cited references do not provide any motivation for combining the references to form the invention claimed in claims 15, 17, 21, 55-58, 64 and 65 are and therefore do not form a *prima facie* case of obviousness. Additionally, even a combination of the references does not teach

¹ Applicants respectfully submit that the Examiner previously did not explain in the Restriction Requirement of June 28, 2005 why she doubts the truth or accuracy of any statement in the Specification, and also did not back up her assertions in the Restriction Requirement with acceptable evidence or reasoning which is inconsistent with the contested limitation (*i.e.*, that the ACH and automated banking system do not receive the physical check). Further, the rejection as stated in the Restriction Requirement failed to "focus on those factors, reasons, and evidence that lead the examiner to conclude that the specification fails to teach how to make and use the claimed invention without undue experimentation, or that the scope of any enablement provided to one skilled in the art is not commensurate with the scope of protection sought by the claims." See MPEP § 2164.04 (emphasis in original). Additionally, there were no "specific technical reasons" provided in support of this rejection, which are "always required." See MPEP § 2164.04.

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each and every limitation of the inventions of claims 15, 17, 21, 55-58, 64 and 65. Accordingly, Applicants respectfully submit that this rejection should be withdrawn.

A Claims 15, 17 and 55.

Claims 15, 17 and 55 have been rejected as allegedly unpatentable under 35 U.S.C. § 103(a) over USPN 5,819,236 to Josephson in view of Zeanah in view of Geer. See Office Action at ¶ 5. Applicants respectfully submit that there is no motivation in the cited references to combine the teachings therein, and therefore do not form a *prima facie* case of obviousness. Further, Applicants respectfully submit that the combination of Josephson, Zeanah and Geer does not disclose each and every limitation of claims 15, 17 and 55, as amended.

The Examiner asserts, with respect to claim 15, that Josephson teaches “(a) receiving conventional checks payable to a bank customer payee (col. 8, lines 1-11); and entering transaction data into the customer terminal (col. 6, lines 61-65, col. 8, lines 6-11 and fig. 1 (130 - a keyboard for entering transaction data)); and (e) receiving by the bank customer a result of the transaction for each check (col. 8, lines 34-40 and lines 49-57).” See Office Action at ¶ 5. The Examiner further asserts that Geer teaches “(d) processing the discrete value of each check for deposit by the automated banking system without physical receipt of the conventional check by the automated banking system (col. 6, lines 40 - col. 7, line 61 and col. 8, lines 1-27).” *Id.* The Examiner finally asserts that Zeanah teaches “(b) logging the bank customer payee onto an automated banking system from a customer terminal that is remotely situated with respect to a bank, and the automated banking system (col. 20, lines 29-39).” The Examiner concludes that it “would have been obvious to one having ordinary skill in the art at the time the invention was made to log the bank customer payee onto an automated banking system from a customer terminal that is remotely situated with respect to a bank and the automated banking system and to modify Josephson because such a modification would allow Josephson to have a secure customer terminal for transacting business in an automated banking system.” *Id.*

1. Modifying Josephson with the teachings of Geer and Zeanah constitutes improper hindsight.

Applicants respectfully submit that there is no motivation in Josephson to modify it with the teachings of Geer and Zeanah, and so the proposed combination here constitutes improper

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hindsight. See MPEP § 2143 ("In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination or other modification," citing *In re Linter*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). This motivation must be either explicit or implicit. See MPEP § 2143. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art," citing *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." See MPEP § 2134, citing *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). (emphasis in original).

Specifically, when a primary reference is missing elements, the law of obviousness requires that the Office set forth some motivation why one of ordinary skill in the art would have been motivated to modify the primary reference in the exact manner proposed. See *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 664 (Fed. Cir. 2000). In other words, there must be some recognition that the primary reference has a problem and that the proposed modification will solve that exact problem. All of this motivation must come from the teachings of the prior art to avoid impermissible hindsight looking back at the time of the invention.

In the present case, the Office Action's sole justification for modifying Josephson has absolutely nothing to do with any deficiencies of Josephson. To properly modify Josephson to correct for deficiencies, the Office has the burden to show some motivation why providing those elements would have overcome some perceived problem with Josephson. Any such motivation is completely lacking. Therefore, this is a clear example of improper hindsight. The Office has the burden to show a suggestion or motivation found somewhere in the prior art regarding the desirability of the modification of Josephson. See MPEP § 2143.01; see also *In re Mills*, 16 USPQ2d at 1432; *In re Fritz*, 23 USPQ2d 1780 (Fed. Cir. 1992). In addition, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both

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be found in the prior art, not in Applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Here, Josephson discloses an electronic system and method for providing advance notification of a potential return that may occur when a presenting financial institution ("FI") eventually presents an item for payment to a paying FI in a subsequent paper-based presentment process. See Abstract. The invention addresses deficiencies of the prior art, for example the delay that occurs between the time a check is deposited at a sending FI and the time the paying FI pays the money to the sending FI. See col. 2, lines 28-33. During this delay, the sending FI must either place a hold on the check depositor's account for the amount of the check, or else incur the risk that the paying FI will reject the check. See col. 2, lines 31-36. However, federal law imposes time limits on the length of time a sending FI can retain a hold on depositor's funds. See col. 2, lines 40-45. The invention addresses these deficiencies by maintaining a database of restricted account data. See col. 4, lines 24-27. When a sending FI captures item data from an item, such as a deposited check, the item data are checked against the restricted account data to determine whether the item is drawn on an account that the paying FI has restricted. See col. 4, lines 27-31.

Thus, Josephson addresses the problem incurred by a FI to reduce the delay that occurs between the time beginning *after* a check is deposited at a sending FI and the time the paying FI pays the money to the sending FI. Josephson solves this problem by maintaining a database of restricted account data *at the FI*. The sole justification for combining these references stated in the Office Action, however, is to "allow Josephson to have a secure customer terminal for transacting business in an automated banking system." Josephson, however, does not suggest that there is a problem in the manner of depositing items with the FI in the first instance but rather that the problem to be solved occurs only *after* a check has been deposited with the sending FI. Applicants respectfully submit that there is no motivation found in Josephson to modify it by the teachings of Geer and Zeanah to "allow Josephson to have a secure customer terminal for transacting business in an automated banking system" because there is no perceived problem in Josephson that would require providing a secure customer terminal for transacting business in an automated banking system. Accordingly, there is no motivation in Josephson to

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modify it with the teachings of Geer and Zeanah at all, and the combination in forming this rejection constitutes is improper hindsight.

Applicants therefore respectfully request that this rejection be withdrawn. Since claim 55 was rejected for the similar rationale as claim 15, the rejection of claim 55 should be withdrawn for the same reasons. See Office Action at ¶ 5.

2. The improper combination of Josephson, Geer and Zeanah does not teach each and every limitation of claim 15.

Additionally, the improper combination of Josephson, Geer and Zeanah does not teach each and every limitation of claim 15. Specifically, the combination of these references does not teach at least the limitations of claim 15, as amended, of (a). logging a bank customer payee onto an automated banking system through a customer terminal that is remotely situated with respect to a bank and the automated banking system, wherein the bank customer payee is the recipient of a conventional check payable to the bank customer payee; and (b). receiving transaction data that was entered into the customer terminal by the bank customer payee, wherein the transaction data comprises routing number, account number, date written and amount of the conventional check.

For this additional reason. Applicants respectfully submit that these references do not support a *prima facie* case of obviousness and request that this rejection be withdrawn.

3. The rejection of claims 17, 55, 68-70 and 74-76 should be withdrawn for the same reasons as for claim 15.

Claim 17 is dependent from claim 15 so the rejection of claim 17 should be withdrawn for the same of reasons as for claim 15. Since claim 55 was rejected for the similar rationale as claim 15, the rejection of claim 55 should be withdrawn for the same reasons. See Office Action at ¶ 5.

4. Claims 68-70 and 74-76 are not unpatentable under 35 U.S.C. § 103(a) since these claims depend from claims 15 and 55.

Finally, since new claims 68-70 and 74-76 are dependent from claims 15 and 55, these claims should not be rejected under 35 U.S.C. § 103(a) similar rationale.

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B. Claims 21, 56-58, 64 and 65.

Claims 21, 56-58, 64 and 65 have been rejected as allegedly unpatentable under 35 U.S.C. § 103(a) over Josephson and Gustin in view of Geer. *See Office Action at ¶ 6.* Applicants respectfully submit that the combination of Josephson, Gustin and Geer does not disclose each and every limitation of claims 21, 56-58, 64 and 65, as amended, and therefore do not form a *prima facie* case of obviousness. Further, Applicants respectfully submit that there is no motivation in the cited references to combine the teachings therein.

The Examiner asserts with respect to claim 21 that “Josephson teaches, A computerized system for allowing a bank to process check deposit transactions that are initiated by a bank customer at a remote location, comprising: (a.) receiving a request from a bank customer on a terminal that is remotely situated from a bank for authorization to make a transaction using an automated banking system, wherein the terminal is remotely situated from the automated banking system (col. 4, lines 56-65 and col. 5, lines 26-63 and fig. 1).” *See Office Action at ¶ 6.* The Examiner asserts that Gustin teaches “authorizing a bank customer payee as a user on the automated banking system (fig. 8 (300, 308 & 310), fig. 8A, and fig. 8B - shows authorizing a customer payee as a user of the automated banking system); and (c.) receiving transaction data related to the deposit of a conventional check payable to the bank customer, where the payor is someone other than the bank customer (col. 12, lines 3-47, col. 19, line 56 - col. 20, line 63, Fig. 13E, Fig. 13F, fig. 20, fig. 20A, Fig. 20B, fig. 20C, Fig. 20E, and Fig. 20F).” *See id.* The Examiner further asserts that Geer teaches “(d.) processing the transaction for the discrete value of each check without physical receipt of the conventional check by the automated banking system (col. 6, lines 40- col. 7, line 61 and col. 8, lines 1-27).” *See id.* The Examiner concludes that it “would have been obvious to one having ordinary skill in the art at the time the invention was made to log the bank customer payee onto an automated banking system from a customer terminal that is remotely situated with respect to a bank and the automated banking system and to modify Josephson because such a modification would allow Josephson to not have physical paper checks transported from the bank customer’s location and to have the information from the checks extracted and converted into electronic form.” *Id.*

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1. Modifying Josephson with the teachings of Geer and Gustin constitutes improper hindsight.

Applicants respectfully submit that there is no motivation in Josephson to modify it with the teachings of Geer and Gustin, and so the proposed combination here constitutes improper hindsight for the same reasons stated previously for claim 15. Again, the Office Action has not shown a perceived problem with Josephson that would be corrected by the teachings of Geer and Gustin.

As stated, Josephson addresses the problem incurred by a FI to reduce the delay that occurs between the time beginning *after* a check is deposited at a sending FI and the time the paying FI pays the money to the sending FI. Josephson solves this problem by maintaining a database of restricted account data at the FI. The sole justification for combining these references stated in the Office Action, however, is to "allow Josephson to not have physical paper checks transported from the bank customer's location and to have the information from the checks extracted and converted into electronic form." Josephson discloses that checks are received from a variety of sources (for example, over-the-counter, drive-in depositories, automated teller machines ('ATMs'), mail or lockboxes." See col. 8, lines 2-7. Josephson discloses methods for capturing item data from items received by the sending FI from its depositors, which include use of MICR (magnetic ink detection circuitry) technology; machine vision; or manually. Josephson, however, does not suggest that there is a problem in the manner of depositing items with the FI in the first instance but rather that the problem to be solved occurs only *after* a check has been deposited with the sending FI. There is nothing in the teachings of Josephson that suggest that extraction of check information or conversion of check information into electronic form is desirable. Applicants respectfully submit that there is no motivation found in Josephson to modify it by the teachings of Geer and Gustin to "allow Josephson to not have physical paper checks transported from the bank customer's location and to have the information from the checks extracted and converted into electronic form" because there is no perceived problem in Josephson in receiving items deposited in the FI. Accordingly, there is no motivation in Josephson to modify it with the teachings of Geer and Gustin at all, and the combination in forming this rejection constitutes is improper hindsight.

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Applicants therefore respectfully request that this rejection be withdrawn.

2. **The improper combination of Josephson, Geer and Gustin does not teach each and every limitation of claim 21.**

Additionally, the improper combination of Josephson, Geer and Gustin does not teach each and every limitation of claim 21. Specifically, the combination of these references does not teach at least the limitations of claim 21, as amended, of "(a.) receiving a request from a bank customer payee who enters the request through a terminal that is remotely situated from a bank for authorization to make a transaction using an automated banking system, wherein the terminal is remotely situated from the automated banking system, wherein the bank customer payee is the recipient of a conventional check payable to the bank customer; (b.) authorizing the bank customer payee as a user on the automated banking system; and (c.) receiving transaction data that is entered into the terminal by the bank customer payee, wherein the transaction data is related to the deposit of the conventional check, where the payor of the conventional check is someone other than the bank customer payee."

For this additional reason, Applicants respectfully submit that these references do not support a *prima facie* case of obviousness and request that this rejection be withdrawn

3. **The rejection of claims 56-58, 64 and 65 should be withdrawn for the same reasons as for claim 55.**

Claims 56-58, 64 and 65 are dependent from claim 55 so the rejection of these claims should be withdrawn for the same of reasons as for claim 55. See Office Action at ¶ 6.

4. **Claims 71-73 are not unpatentable under 35 U.S.C. § 103(a) since these claims depend from claim 21.**

Finally, since new claims 71-73 are dependent from claim 21, these claims should not be rejected under 35 U.S.C. § 103(a) similar rationale.

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CONCLUSION

Applicants respectfully submit that claims 15, 17, 21, 55-58, 64, 65 and 68-76 are in condition for allowance and request allowance of the same.

Applicants authorize the Commissioner to charge a fee of \$1020.00 for a three month extension of time. If any variance from this amount is determined, the Commissioner is hereby authorized to deduct such fees from or credit any overcharges to the undersigned's Deposit Account No. 50-0206.

Respectfully submitted,

HUNTON & WILLIAMS LLP

By:



Nancy J. Flint
Registration No. 46,704

Dated: May 5, 2006
Hunton & Williams LLP
Intellectual Property Department
1900 K Street, N.W.
Suite 1200
Washington, DC 20006-1109
(305) 810-2522 (telephone)
(305) 810-1615 (facsimile)

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